

REMARKS/ARGUMENTS

This Amendment responds to the Office Action dated February 3, 2003.

In amended Figure 4, the previously omitted designation --PRIOR ART-- has been added.

Claims 21-27 have been withdrawn as non-elected claims pursuant to the earlier Restriction Requirement. Applicant acknowledges the Examiner's treatment of the election of claims 1-20 as an election without traverse. Applicant reserves the right to prosecute the non-elected claims in a divisional application.

Claims 12 and 13 have been amended to particularly point out and distinctly claim the subject matter applicant regards as his invention.

A diligent effort has been made to respond to each of the rejections contained therein. It is believed that this Amendment overcomes those rejections and thus places this case in condition for allowance. The rejections of pending Claims 1 - 20 are respectfully traversed, and reconsideration is respectfully requested. Application respectfully requests that a timely Notice of Allowance be issued in this case.

I. The Examiner Has Failed To Demonstrate A *Prima Facie* Case of Anticipation Utilizing The *Albrecht* Reference

Claims 1-3 and 12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Albrecht*, U.S. Patent No. 4,962,633. 02/03/03 Office Action, p. 3. To establish a *prima facie* case of anticipation under 35 U.S.C. § 102, the Examiner must demonstrate that a single prior art reference discloses all of the claim's essential elements. *E.g.*, *Rockwell Inter. Corp. v. U.S.*, 147 F.3d 1358, 1363, 47 U.S.P.Q.2d 1027, 1031 (Fed. Cir. 1998); *Gechter v. Davidson*, 116 F.3d 1454, 1457, 43 U.S.P.Q.2d 1030, 1032 (Fed. Cir. 1997); *In re Donohue*, 766 F.2d 531, 534, 226

U.S.P.Q. 619, 621 (Fed. Cir. 1985); *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Thus, the "exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference." *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 750 F.2d 1569, 1574, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984).

A. Albrecht Does Not Disclose a Building Panel Including a Curved Central Portion With Side Wall Portions Extending From Its Opposite Ends

The building panel of claim 1 includes a curved central portion and a pair of *side* portions. The side portions extend from the opposite *ends* of the curved central portion. *Albrecht* does not disclose a curved central portion with side portions extending from its *ends*.⁵ Rather, *Albrecht* discloses a "flat region." The flat region comprises "lateral crest 80" that "is provided with at least one and preferably two longitudinally extending first stiffening ribs 92" *Albrecht*, col. 4, ll. 64-68. The Examiner has described the stiffening rib 92 of *Albrecht* as a curved central portion. This is incorrect because *Albrecht* clearly describes a "flat region" as described:

In its broadest aspects, the present invention provides improvements in cold formed, profiled building units of the type used as floor, roof or wall elements. *The profiled building unit* is formed from a sheet metal strip of substantially uniform sheet thickness and *having at least one flat region* that is subject to buckling under compressive forces. *Examples of such flat regions include the crests and the valleys of profiled floor deck and roof deck, and of profiled facing sheets used as the exposed face of wall and roof structures; and the flat central web of liner sheets used as the interior face of wall structures.*

In accordance with the present invention, at least one stiffening rib is formed *in the flat region*.

Albrecht, col. 2, ll. 43-56. In other words, *Albrecht*, neither discloses nor claims a curved central portion as claimed. Rather, *Albrecht* discloses a flat region.

Figures 3, 4, 17 and 18 of *Albrecht* depict graphically that lateral crest 80 is not curved, but rather is a flat region as described. Furthermore, those Figures of *Albrecht* show that while stiffening rib 92 is curved in cross-section, it is only part of the larger flat region comprising lateral crest 80. The stiffening rib 92 of *Albrecht* has no side wall portions extending from its opposite ends, and thus cannot anticipate the curved central portion of the building panel of claim 1. A building panel with a flat region central portion, as disclosed in *Albrecht*, is clearly different than a building panel having a curved central portion as claimed. Thus, *Albrecht* does not provide the requisite disclosure to anticipate claim 1.

Applicant also notes that even in what *Albrecht* describes as its "broadest aspects," the building panel of *Albrecht* includes a flat region central portion, not a curved central region. By attempting to characterize the stiffening rib 92 of *Albrecht* as a curved central portion, the Examiner is attempting to interpret *Albrecht* more broadly than even the inventor contemplated.

Applicant has clearly distinguished building panels similar to those in *Albrecht* from the building panel of claim 1: "Unlike the panel 400 illustrated in Fig. 4, which has a straight central portion 402, the panel of the present invention, as illustrated in Fig. 9, includes a curved central portion 902." Application, p. 10 (emphasis added). Furthermore, Applicant has distinguished building panels having flat region central portions that include stiffening ribs as in *Albrecht*.

The central portion 402 is straight, and in order to increase that portion's stiffness it may include a notched portion 408. Assuming the central portion includes a notched stiffener, the central portion 402 would be separated into two sub-central portions 404, 406.

Application, p. 2. The Examiner's designation of the stiffening rib 92 of *Albrecht* as a curved central portion and the Examiner's designation of lateral crest 80 as a side wall portion is inconsistent with the disclosure in *Albrecht*. Furthermore, the Examiner's designation of the

stiffening rib 92 of *Albrecht* as analogous to a curved central portion is inconsistent with the language of claim 1, which particularly points out and distinctly claims the subject matter that *Applicant* regards as his invention.

B. *Albrecht* Does Not Disclose a Panel Having Side Wall Portions Extending From Opposite Ends of the Curved Central Portion

The Examiner also fails to establish a *prima facie* case of anticipation because the Examiner has not demonstrated that *Albrecht* discloses a side wall portion extending from opposite ends of a curved central portion, as claimed in claim 1. Consistent with the disclosure in *Albrecht* as described above and the language of claim 1, Figures 3, 4, 17 and 18 of *Albrecht* depict a building panel including "alternating crests 80 and valleys 82, and sloped webs 84." *Albrecht*, col. 4, ll. 57-58. By describing the sloped web 84 of *Albrecht* as the complementary wing portion of claim 1, the Examiner misinterprets both *Albrecht* and Applicant's claimed invention. By its description, the *sloped* web 84 of *Albrecht* is not properly described as a complementary wing portion extending *from a side wall portion* that extends from the *end* of a curved central portion, as recited in claim 1. For this reason and the one stated above, the Examiner has failed to establish a *prima facie* case of anticipation. As in this case, where the Examiner fails to establish a *prima facie* case of anticipation, the rejection is improper and shall be reversed. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

II. The Examiner Has Failed To Demonstrate A *Prima Facie* Case of Obviousness Utilizing The *Albrecht* Reference

Claims 4-11 and 13-20¹ stand rejected under 35 U.S.C. § 103(a) as being obvious in view of *Albrecht*. 08/29/01 Office Action, p. 3. The Examiner can satisfy her burden of establishing a

¹ Examiner indicated in the Office Action that "claims 4-11, 14-17 [sic] are rejected under 35 U.S.C. 103(a)." However, the Examiner referred specifically to claims 14-20 in her rejection under 35 U.S.C. 103(a).

prima facie case of obviousness "**only by showing some objective teaching** in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (emphasis added). In this case, the Examiner cites only one reference, *Albrecht*, to render Claims 4-11 and 13-20 obvious. Modifying a single reference to support a determination of obviousness is improper absent a sufficient teaching or suggestion in the prior art to make such a modification. See *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) (stating that "[a]lthough couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art"). Thus, modifications to a prior art reference are improper without evidence of a

specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of [the applicant's] invention to make the combination in the manner claimed.

In re Kotzab, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (holding that the Board did not make out a proper *prima facie* case of obviousness when it modified a single reference without a specific motivation to make such a modification).

Here, consistent with the above remarks, it is clear that *Albrecht* does not disclose all of the claimed elements. Thus, the Examiner must point to some particular teaching or suggestion in *Albrecht* that supports modifying the reference to provide a building panel including a curved central portion and side wall portions extending from opposite ends of the curved central portion.

(continued...)

Applicant assumes that the indication on the Office Action Summary that claims 1-20 are rejected is correct, and further that claim 13 is included in the rejection under 35 U.S.C. 103(a).

as claimed in independent claims 1 and 14. The Examiner has failed to cite any support in *Albrecht* that suggests modifying the reference in such a manner because such a teaching does not exist. In fact, *Albrecht* describes the "broadest aspects" of the building panel disclosed, and admits that even in its broadest aspects, the building panel of *Albrecht* includes a flat region central portion. *Albrecht*, col. 2, ll. 43-56.


As discussed above, a lack of evidence showing some objective teaching in *Albrecht* or that knowledge generally available to one of ordinary skill in the art that would lead that individual to modify *Albrecht* necessitates the removal of the current obviousness rejection.

III. Summary

Because *Albrecht* neither discloses (i) a building panel including a curved central portion nor (ii) a building panel including a pair of side portions extending from the opposite ends of the curved central portion, the Examiner has failed to establish a *prima facie* case of anticipation against Claims 1-3 and 12. Also, because the Examiner has not pointed to any specific evidence that suggests modifying *Albrecht* in the manner claimed in Claims 4-11 and 13-20, the Examiner has not established a *prima facie* case of obviousness against those claims. For the reasons stated above, Applicant believes those claims, as currently presented, are in condition for allowance and respectfully requests reconsideration and allowance of the pending claims.

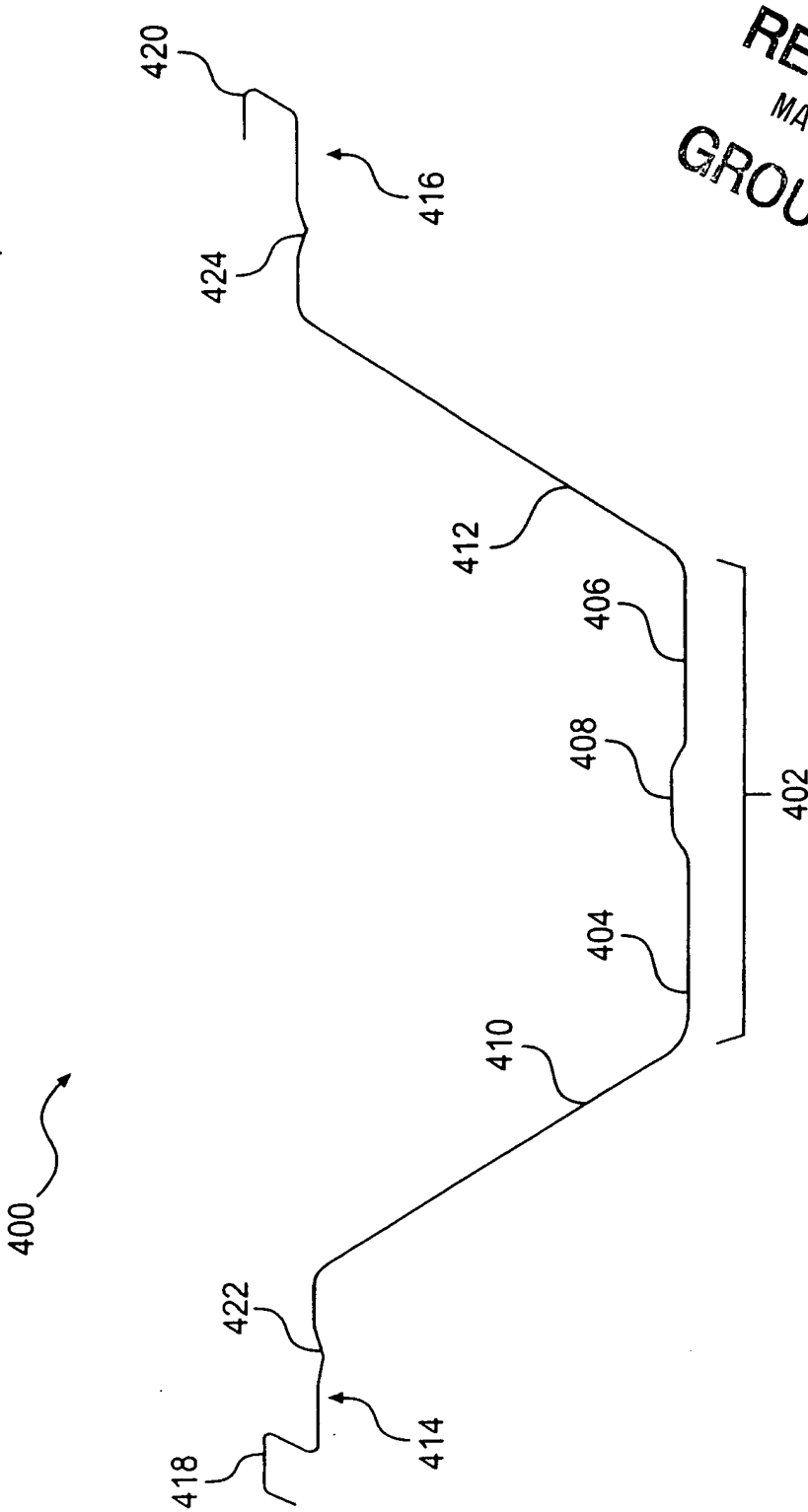
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FIG. 4
PRIOR ART